



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/433,202	11/04/99	REITZ	H N19.12-0026

IM62/0925

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EXAMINER

MARCHESCHI, M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 09/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/433,202

Applicant(s)

Reitz et al.

Examiner

Michael Marcheschi

Group Art Unit

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☒ Responsive to communication(s) filed on Jun 2, 2000.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-28 and 31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-28 and 31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The application papers are objected to (~~claims objected to~~) because they are not a permanent copy as required by 37 CFR 1.52(a). Reference is made to the claims which are easily erasable.

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP § 608.01.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

~~Claim 27 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.~~

Claim 27 is indefinite because the examiner is unclear as to what the "plurality of compositions" are, thus rendering the scope of the claim unclear.

Claims 1-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Ishitobi et al. alone or in view of Farkas et al., (2) Grover et al. alone or in view of Farkas et al. or (3) Kaufman et al. alone or in view of Farkas et al for the same reasons set forth in the previous office action which are incorporated herein by reference.

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Claims 1-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Miyashita et al. in view of Farkas et al. or (2) Brancaleoni et al. in view of Farkas et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-4, 7-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Picardi et al. in view of Ishitobi et al. and Farkas et al., (2) Hirabayashi et al. in view of Ishitobi et al. and Farkas et al. or (3) Sasaki in view of Ishitobi et al. and Farkas et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Atsugi et al. in view of Ishitobi et al. and Farkas et al. or (2) Rostoker et al. (194) in view of Ishitobi et al. and Farkas et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-4, 7-18, 23-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haisma et al. in view of Ishitobi et al. and Farkas et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-28 and 31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either (1) all the pending claim of copending Application No. 08/961,735 in view of Ishitobi et al. and Farkas et al., (2) claims 9-15 of copending Application No. 09/085,514 in view of Ishitobi et al. and Farkas et al., (3) claims 9-15 of copending Application No. 09/136,483 in view of Ishitobi et al. and Farkas et al., or (4) all the pending claims of copending Application No. 09/266,202 in view of Ishitobi et al. and Farkas

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et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 6/2/00 have been fully considered but they are not persuasive.

Applicants argue the indefinite rejection of claim 27 because the instant specification sets forth what compositions can be used. This does not negate the above indefinite rejection. It is suggested that specific types of compositions be defined in this claim.

Applicants argue that the references fail to establish a prima facie case of obviousness because all of the claimed limitations are not taught or suggested. The examiner is unclear as to this argument because all the references teach sizes within the claimed ranges and since a range is defined, a distribution is implied. Although the claimed distribution is not **literally defined** in many of the references, it is the examiners position that from the particle size ranges defined by the references, these specific distributions can be apparent. In other words, the ranges defined by the references imply a variety of distributions, including the claimed ones. **In view of this, all of the claimed limitations are suggested or apparent.** With respect to Rostoker, this reference literally defines a distribution which reads on the claimed distribution. Applicants also argue that the particle size distribution of Rostoker et al. (194) is a gaussian distribution with a corresponding large tail. Applicants have not provided any evidence to support this. The conventional definition of a gaussian distribution is that the distribution curve has the shape of a normal probability curve (bell curve). This definition does not set forth that the distribution has a

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large tail. To support applicants contention, a reference directed to Siegel et al. is supplied. The examiner fails to see the relevance of this article and how it can be used to support applicants argument. Applicants apparently argue that the particles produced by the Siegel et al. patent do not have the claimed distribution and that the particles defined by Rostoker are those of the Siegel patent. This argument ignores the teaching in claim 10 of Rostoker which states that the particles must have the distribution defined.

Applicants set forth that the IDS submitted with the amendment defines 4 relevant references which shows evidence that polishes generally have not been known with the claimed characteristics. These references are acknowledged and considered, but the examiner fails to see the relevance of them, especially since all of the cited references used in the above rejections teach and/or suggest the instant claims. Although these patent (on the IDS) might not define the instant claims, they do not provide any clear evidence which might be used to overcome the patents used in the rejections (i.e. these patents might not show the claimed invention, but this does not mean that the claimed particle sizes are not known by the teachings of other patents). The fact remains that the references applied all teach sizes within the claimed range, irrespective of what other patents (not used in the rejections) might teach. Since all the patents applied teach sizes, and therefore suggest distributions, **they must have been made or obtained from an outside source, contrary to applicants position on page 11, third full paragraph.** Even if they were obtained from outside sources, the particles still have a size (and distribution) within the claimed range. Applicants argue claim 31 in that their highly uniform particles gave surprisingly high

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grinding rates. Applicants must show convincing evidence (declaration) to support this and compare the claimed grinding rates to the inherent grinding rates of the references.

Since applicants have not provided any evidence (data) showing that the claimed size range is superior and provides unexpected results when compared to the size ranges disclosed by the prior art, no patentable distinction is seen to exist. In the absence of a declaration showing unexpected results, the examiner fails to see any patentable distinction between the claimed invention and the references.

NOTE:

The declaration needs to show unexpected results with respect to some kind of property. Since the claims are directed to “a collection of particles”, the examiner is unaware as to how evidence can be shown (what the unexpected property will be). It is suggested that the claims be directed to a polish and the unexpected results show a difference in the polishing properties.

Applicants apparently argue the enablement of the references and this is an improper argument. If applicants are stating that the references are not enabling, they are requested to submit a preponderance of evidence to support this. **All US patents are deemed valid.**

With respect to the combination rejection of claims, applicants fail to argue the reasons for combining as set forth in the previous office action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Finally, applicants argue the ODP rejections because they **believe** that the copending applications fails to disclose the distribution set forth in claims. Although this is feature is not literally defined, it is the examiners position that from the particles size ranges defined by the copending application, this specific distribution can be apparent. In other words, the ranges defined by the copending application imply a variety of distributions, including the claimed ones.

In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)".

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The additional references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
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9/00


MICHAEL MARCHESCHI
PRIMARY EXAMINER